

REMARKS

Claims 1-25 remain pending in this application. Applicant has amended claims 1, 5, 9, 14, 18, and 22.¹ In the Office Action mailed October 30, 2008², the Examiner rejected claims 1-25 under 35 U.S.C. 103 as allegedly being obvious over Wolfberg et al. (U.S. Patent 5,214,579, "*Wolfberg*") in view of Sullivan et al. (U.S. Patent No. 6,615,240, "*Sullivan*") and further in view of Farry et al. (U.S. Patent No. 6,069,629, "*Farry*").

In the Advisory Action mailed February 17, 2009, the Examiner refused to allow Applicants claims "for the reasons stated" in the October 20, 2008 Office Action. Rejecting the claims "for the reasons stated" in the final Office Action implies that the Examiner has not set forth any reasons for disagreeing with Applicant's specific arguments from the December 30, 2008 after-final response. Thus, Applicant has included those arguments again in this response for the Examiner's review and reconsideration.

In view of the arguments raised in the December 30, 2008 response (repeated below) and in view of the amendments made herein, all of the pending claims are allowable over the art of record, and Applicant respectfully requests that the Examiner reconsider and allow the pending claims.

¹ Claims were amended solely to expedite prosecution. Applicant preserves the right to pursue the original subject matter in subsequent applications.

² The Office Action contains a number of statements reflecting characterizations of the related art and claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

Independent Claims 1, 9, and 18

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.” M.P.E.P. § 2141(III). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III). In the Office Action, there must be “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” M.P.E.P. § 2141(III). For at least reasons below, Applicant’s claims are not obvious over the art of record.

Claim 1 recites, for example, “providing a second window for displaying context sensitive automated coaching determined by the selected service level, the life intentions, and the user’s communication, wherein the automated coaching is driven by a financial coaching system that comprises one or more coaching engines,” “providing a risk modeling component for allowing the user to control the level of risk, by allowing the user to select one or more risk events from a list of risk events; based on actuarial data from at least one external database, providing estimates of a probability and effect of an occurrence of the selected one or more risk events; and for each individual risk event from the selected one or more risk events, allowing the user to accept the estimate associated with the risk event, or to reject the estimates and substitute in a different

estimate,” and “providing a communication component for allowing the user to respond to the portfolio modeling, the automated coaching, and the live coaching of the selected service level, wherein the automated coaching incorporates the selected risk events,” among other features.

Wolfberg, Sullivan, and Farry all fail to disclose or suggest at least these features. None of the art of record, for instance, uses “actuarial data from at least one external database” to provide “estimates of a probability and effect of an occurrence of ... one or more risk events” selected by the user, “allowing the user to accept ... or reject the estimate,” and “incorporating the selected risk events” in the “automated coaching.”

Claim 1 also recites, for example, “providing a communication component for allowing the user to respond to the portfolio modeling, the automated coaching, and the live coaching of the selected service level, wherein the automated coaching incorporates the selected risk events, wherein the communication component captures the user's communication which is responsive to the context sensitive automated and live coaching, and wherein the user's response comprises modifications to the life intentions initially received from the user” (emphasis added).

The Office Action of October 20, 2008 addressed the phrase “initial values” that appeared in Applicants’ August 4, 2008 remarks. In those remarks, Applicants stated that *Wolfberg* only disclosed providing projections based on a participant’s provision of initial values, and pointed out *Wolfberg* at column 1, lines 55-69, which discloses that projections are made based on an initial investment and monthly supplemental investments. Likewise, Applicants pointed to *Wolfberg* at column 3, lines 45-50, which

discloses that the participant selects an initial investment amount, the amount of monthly investments, and the desired target investment goal.

The Office Action of October 20, 2008 appears to characterize *Wolfberg's* "supplemental" monthly payments as "modifications to life intentions" as recited by claim 1. This is incorrect. Supplemental monthly investments are simply deposits of money. See *Wolfberg*, column 3, lines 45-50. Without deposits of money after an initial investment, there would be little to predict. Indeed, a prediction that does not assume subsequent deposits will occur is not a prediction at all, but an observation. *Wolfberg* thus discloses that the user initially sets an amount for monthly investments. *Id.*

The Office Action further points to *Wolfberg* at column 9, lines 27-38 as disclosing "many other updates or changes." But the cited portion discloses a set of "demand processing tasks" such as purchases or loans. Like planned monthly deposits of money, these tasks are also not "modifications to life intentions" as recited by claim 1. *Wolfberg* also discloses, in column 16, lines 26-28, that participants may modify their payment schedule, which in turn modifies the projections. But increasing a monthly payment does not comprise a user modifying "life intentions;" it merely gets the user to an existing goal faster. See, e.g., *Wolfberg*, column 1, lines 63-67.

To the contrary, *Wolfberg* states that the initial investment goal is "fixed." See, e.g., column 2, lines 19-23. Once the goal is set, the system disclosed by *Wolfberg* focuses on meeting that goal. If the user's deposits are such that the goal will be exceeded, and the user will contribute for the same number of months as originally planned, then the *Wolfberg* system can update, on its own, the "target amount of funds that will be generated at the end of the original number of years." See, e.g., column 20,

lines 31-36. Never does the user update any “life intentions.” Further, the *Wolfberg* system only updates projections periodically, i.e., “on a monthly basis,” and would therefore be incapable of operating in conjunction with any system that provides “live coaching” or “context sensitive automated coaching.” See, e.g., column 16, lines 4-27. For this reason, *Wolfberg* teaches away from any combination adding any system that offers “live coaching” including the system disclosed in *Sullivan*.

As explained in detail above, the differences between the claimed invention and the prior art have not been properly ascertained in the Office Action, and no rational underpinning to support the legal conclusion of obviousness has been provided. Accordingly, no reason has been clearly articulated as to why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art. Thus, the rejections should be withdrawn and the claims should be allowed.

In light of the new claim amendments presented herein and the shortcomings of the October 20, 2008 Office Action, claim 1 is unobvious over the art as described above. Therefore, the rejection of claim 1 under 35 U.S.C. 103(a) should be withdrawn.

Independent claims 9 and 18 recite similar elements as claim 1, although they differ in scope from each other and from claim 1. Each has also been amended in a similar manner to claim 1, so that, for example, each recites using “actuarial data from at least one external database” to provide “estimates of a probability and effect of an occurrence of … one or more risk events” selected by the user, “allowing the user to accept … or reject the estimate,” and “incorporating the selected risk events” in the “automated coaching.”

Also like claim 1, claims 9 and 18 also recite that the “user's communication” “is responsive to the context sensitive automated and live coaching,” and that “the user's response comprises modifications to the life intentions initially received from the user.”

For similar reasons to those discussed above with regard to claim 1, the rejection of independent claims 9 and 18 under 35 U.S.C. 103(a) should be withdrawn.

The Examiner rejected dependent claims 2-8, 10-17, and 19-25 under as 35 U.S.C. 103(a) as being unpatentable over *Wolfberg* in view of *Sullivan* and further in view of *Farry*.

As stated, each of these claims is a dependent claim, and thus includes all the elements of its respective independent claim. All the independent claims are unobvious over the art of record, for at least the reasons set forth above. “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” M.P.E.P. 2143.03 (citing *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988)). Accordingly, the rejection of dependent claims 2-8, 10-17, and 19-25 under 35 U.S.C. 103(a) should be withdrawn as well.

In view of the foregoing remarks, Applicants submit that this claimed invention, is not obvious in view of the prior art references cited against this application. Applicants therefore request the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Application No. 09/704,838
Attorney Docket No. 10761.0183-05
Customer No. 81,331

Please grant any extensions of time required to enter this response and charge
any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 17, 2009

By:



John S. Sieman
Reg. No. 61,064
Phone: 202-408-4000
Fax: 202-408-4400
Email: john.sieman@finnegan.com